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Docket No.: 325772015300
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Atsushi ITO

Application No.: 09/506,453

Confirmation No.: 8167

Filed: February 18, 2000

Art Unit: 2624

For: PRINTER CAPABLE OF REFUSING RECEIPT
OF PRINTED MATERIALS SENT FROM AN
UNINTENDED SOURCE (as amended)

Examiner: Douglas Q. Tran

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

In response to the restriction requirement set forth in the Office Action mailed January 18, 2005, Applicant hereby elects Group I, claims 1-10 and 12-31, *with traverse*. Applicant reserves the right to file a divisional application directed to the non-elected subject matter.

MPEP 811 states that "the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, or otherwise, as soon as the need for a proper requirement develops. Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required."

The Examiner has already issued two Office Actions on the merits in this case. Applicant has not amended the claims since the original search was conducted by the examiner. Applicant submits that there is no reason to issue a restriction requirement at this time since the

examiner has already conducted a search without restricting the claims. The examiner cannot allege that he would be seriously burdened if the restriction was not required.

Further, according to MPEP 806.05(e), the burden is on the examiner to provide reasonable examples that recite material differences. In other words, the examiner must provide examples of how the process as claimed can be practiced by another materially different apparatus or by hand, or how the apparatus as claimed can be used to practice another and materially different process. The examiner has failed to meet this burden.

Furthermore, the examiner has failed to respond to Applicant's remarks made in the Response filed on August 18, 2004. Applicant requests that the examiner either comment on Applicant's remarks or withdraw the rejections of the Action dated May 19, 2004.

In light of the foregoing, Applicant requests that the outstanding restriction requirement be withdrawn and that the examiner officially respond to the Response filed by Applicant on August 18, 2004.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 32577-2015300.

Dated: February 4, 2005

Respectfully submitted,

By 
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